

**APR 03 2008**Remarks

Claims 16 to 40 are cancelled and claims 41 to 52 are added. Claims 41 to 52 are pending in this application of which claims 41, 51 and 52 are in independent form.

Claim 16 is cancelled and is replaced by added claim 41 which is directed to the embodiment of the applicants' invention shown in FIG. 6.

Claim 16 had been rejected under 35 USC 103(a) as being over Zonneveld in view of Pensel et al and Arai in further view of Spink et al. The following will show that added claim 41 patentably distinguishes the applicants' invention over this combination of references.

As correctly pointed out in the action, Zonneveld in view of Pensel et al do not show a mixer for receiving signals of both image data and an image signal provided by an image sensor from the object image. In the applicants' invention, the image data and the image signal of the object are fed by separate electronic circuits to the mixer.

Applicants' claim 41 includes the feature and limitation of:

"said image recording module further including a mixer connected to said image sensor for receiving said image signal (obtained from the object image) and being connected to said image data supply for receiving said image data to mix said image signal and said image data and generate an output signal;" (parenthetical material added)

Arai is directed only to a projection lens and does not aid

our person of ordinary skill in arriving at the above feature and limitation.

In the action, the view is expressed that Spink et al teaches that one can electronically combine data with an image mixer via inputs for providing an electronic mixed image. However, there is no suggestion in the action as to how our person of ordinary skill could possibly want to seek out Spink et al and even if our person of ordinary skill did so, it is not at all clear that Spink et al could be combined with Zonneveld. More specifically, somehow our person of ordinary skill would first have to hit upon the idea of providing a beam splitter to deflect the object image onto an image sensor which would convert the optical image into an electronic data signal and there is no suggestion to do this in Zonneveld. Accordingly, there is no starting point in Zonneveld from which our artisan could proceed to search for another reference.

Also, the item 89 of Spink et al referred to in the action as being a mixer is rather a data conditioning unit which, as explained at column 13, lines 50 to 52:

"...conditions or converts data in the correct format before they go into a connected work station or when they emerge therefrom,..."

From the above, it is not seen how our person of ordinary skill could simply take item 89 from Spink et al for use as a mixer and insert the same into Zonneveld. Zonneveld does not suggest doing this nor does it give any hint to provide an image sensor to convert the object into an electronic image signal for feeding the same to a mixer.

Starting with Zonneveld, our person of ordinary skill would have at least a two-step process to arrive at the applicants' invention as defined in claim 41. First, our artisan must somehow come upon the idea to provide the electronic data signal of the object image and then our artisan has to hit upon the idea of a mixer. And, even if our artisan would have somehow stumbled on Spink et al, there is real doubt as to whether item 89 would be appropriate. Applicants submit that this is not possible without the exercise of more than just ordinary skill.

In view of the above, applicants submit that claim 41 should now patentably distinguish their invention over the combination of Zonneveld, Pensel et al, Arai and Spink et al.

Claim 41 incorporates the additional feature and limitation of:

"a shutter interposed between said first beam splitter and said object to suppress said object image to facilitate viewing said image data in said viewing unit."

The antecedent basis for this feature is set forth on page 8, lines 6 and 7, of the applicants' disclosure. Nowhere is there a suggestion in the applied references to provide a shutter, let alone, a shutter disposed in the viewing beam path to facilitate viewing the image data in the viewing unit so that this feature places the applicants' invention still farther away from the cited references.

Claims 51 and 52 are added to provide additional independent definitions of the invention. Claim 51 incorporates all the features and limitations of claim 41 except the last feature but also includes the features of dependent claims 42 and 50.

Claim 52 incorporates all the features of claim 41 as well as of claims 42 and 50. Accordingly, claims 51 and 52 too should now patentably distinguish the applicants' invention over the art of record and be allowable.

Claim 42 is directed to the imaging optic of the surgical microscope as shown in FIG. 2 of the applicants' drawings. No suggestion is made in the action as to where in the applied references this particular combination of lenses can be found, let alone, in the context of a set of lenses interposed between an image display unit and the first beam splitter in the further context of a surgical microscope. Claim 42 sets forth the feature of a plano-concave lens and a plano-convex lens with the clause:

"...an imaging optic having a plano-convex lens (37) and a plano-concave lens (33) mounted downstream of said image display unit for transmitting said data image to said first beam splitter." (numerals added)

Claim 43 is more specific and sets forth the particular order of these lenses as shown in applicants' FIG. 2 with the clause:

"...said plano-concave lens (33) is disposed downstream of said image display unit (11) and said plano-convex lens (37) is interposed between said plano-concave lens (33) and said first beam splitter (313, FIG. 6)." (numerals added)

No suggestion is made in the applied reference as to this particular combination of lenses and their respective positions so that this claim too should now be allowable in the context of the surgical microscope set forth in claim 41.

The applicants have shown that independent claims 41, 51

and 52 patentably distinguish their invention over the applied references and should be allowable. Claims 42 to 50 are all dependent directly or indirectly from claim 41 so that they too should be allowable.

Reconsideration of the application is earnestly solicited.

Respectfully submitted,



Walter Ottesen  
Reg. No. 25,544

Walter Ottesen  
Patent Attorney  
P.O. Box 4026  
Gaithersburg, Maryland 20885-4026

Phone: (301) 869-8950

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